

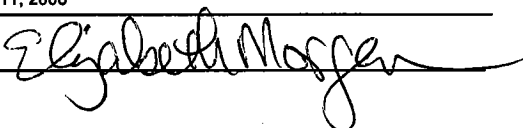

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 073612.0107	
<p>I hereby certify that this correspondence is being deposited with the United States Patent and Trademark Office via the PTO's Electronic Filing System on the date shown below.</p> <p>Date: July 11, 2006</p> <p>Signature: </p> <p>Typed or printed name: Elizabeth Morgan</p>		Application Number 09/829,516	Filed April 9, 2001
		First Named Inventor Richard L. Schwartz et al.	
		Art Unit 2616	Examiner Nguyen Hoang Ngo
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 48,363</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p>		<p> Signature</p> <p>Paula D. Heyman Typed or printed name</p> <p>512.322.2581 Telephone number</p> <p>July 11, 2006 Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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ATTORNEY DOCKET  
073612.0107

PATENT APPLICATION  
09/829,516

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Richard L. Schwartz et al.
Serial No.:	09/829,516
Date Filed:	April 9, 2001
Group Art Unit:	2616
Examiner:	Ngo, Nguyen Hoang
Title:	<b>METHOD AND SYSTEM FOR FACILITATING MEDIATED COMMUNICATION</b>

**MAIL STOP – AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**PRE-APPEAL REQUEST FOR REVIEW**

The following Pre-Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

**REMARKS**

Applicants contend that the rejections of Claims 1-48 on prior art grounds contain clear legal and factual deficiencies, as described below. In a Final Office Action dated January 12, 2006, Claims 1-4, 9, 10, 12, 15, 16, 20 and 22 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,930,700 issued to David J. Pepper et al. (“*Pepper*”). Claims 5-8, 11, 13, 14, 17-19, 21, 23, 28-31, 34, 36, 37, 40-42, 44 and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pepper* in view of U.S. Patent No. 6,493,324 issued to John L. Truetken (“*Truetken*”). Claims 24-27, 32, 33, 35, 38, 39, 43 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pepper*. Applicants request a finding that these rejections are improper and allowance of these claims.

With respect to Claim 1, the Examiner contends that *Pepper* discloses a method comprising “generating a pending mediated commitment based on [an] availability status, the pending mediated commitment indicating a scheduled commitment with a mediated party.” (Final Office Action, Page 3). Specifically, the Examiner “interprets the *forwarding of calls* based on the default profile to correlate to *generating a pending mediated commitment with a calling party*.” (Final Office Action, Page 3) (emphasis added). Applicants contend that *Pepper* does not disclose this limitation for the reasons described in Applicants’ Response dated March 10, 2006 at Pages 18-20. In short, Applicants contend that it is improper to analogize the “generation of a pending mediated commitment” to how an incoming phone call is routed in *Pepper*, as generation of a mediated commitment is distinct from the forwarding of a phone call.<sup>1</sup> For example, as set forth in the March 10, 2006 Response:

Figure 14 illustrates that a mediation subscriber has several pending mediation commitments. As further described by the text associated with Figure 14, a “pending mediated commitment” does not relate to how a call is routed or forwarded to a mediation subscriber, but instead relates to some future event to occur at a scheduled time, for example setting an appointment to conduct a telephone conversation at a later time. Given such context, no portion of *Pepper* teaches, suggests or

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<sup>1</sup> It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that “Applicants are encouraged to refer to arguments already of record rather than repeating them in the request.” Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

discloses “generating” a “commitment,” let alone a “mediated commitment.”

(Response, Page 19).

The Advisory Action mailed March 22, 2006 maintains the rejections made in the Final Office Action and further states:

In response to applicant’s [sic] argument that the references fail to show certain features of applicant’s [sic] invention, it is noted that the features upon which applicant relies (i.e. of having the “pending mediated commitment” relate to some future event to occur at a scheduled time are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read in the claims.”

(Advisory Action, Page 2).

Applicants submit that Claim 1 need not explicitly recite that the pending mediated commitment “relate to some future event to occur at a scheduled time” as argued by the Examiner, as the phrase “pending mediated commitment,” if interpreted consistently with the English language, inherently relates to a future event to occur at a scheduled time. For example, “pending” is defined as, *inter alia*, “not yet decided,” “impending” or “imminent.” (Merriam-Webster’s Collegiate Dictionary, Tenth Edition). “Commitment” is defined as, *inter alia*, “an agreement or pledge to do something *in the future*.” (Merriam-Webster’s Collegiate Dictionary, Tenth Edition) (emphasis added). Thus, it is unreasonable and inconsistent with the English language for the Examiner to correlate how a call is routed or forwarded to a mediation subscriber with a “pending mediated commitment,” as the call routing and forwarding disclosed in *Pepper* does not relate to a “not yet decided,” “impending” or “imminent” event, nor does it relate to “an agreement or pledge to do something in the future.” Thus, given such context, no portion of *Pepper* teaches, suggests or discloses “generating” a “commitment,” let alone a “mediated commitment” or a “pending mediated commitment.”

The Advisory Action also states “[i]t should further be seen that a voice mail box may be used to set up an appointment to conduct a telephone conversation at a later time.” (Advisory Action, Page 2). Whether or not this assertion by the Examiner is true is entirely irrelevant, as *Pepper*, the reference upon which the Examiner relies, discloses only

*forwarding* a message to a voice mail box, but does not disclose a voice mail box that is functional to set up and appointment to conduct a telephone conversation at a later time or to otherwise “generat[e] a pending mediated commitment based on the availability status.” Furthermore, if, as the Examiner alleges, a voice mail box may be used to set up an appointment to conduct a telephone conversation at a later time, *Pepper* does not disclose how such a voice mail box can be used in a method comprising, “facilitating, by [a] mediation system, a mediated follow-through operation for altering the pending mediated commitment according to [an] altered context component, thereby producing an altered mediated commitment,” as recited in Claim 1. In particular, if *Pepper* discloses that a voice mail box may be used to set up an appointment to conduct a telephone conversation at a later time (which the Applicants do not concede) it does not disclose how such appointment (or other mediated commitment) may be altered by the execution of a mediated follow-through operation by a mediation system; instead *Pepper* discloses only the forwarding and routing of messages, not the establishment and/or altering of appointments or other mediated commitments.

For at least the reasons cited above, *Pepper* fails to disclose, teach or suggest each and every limitation of independent Claim 1. Applicants respectfully content that the arguments provided in the Final Office Action and maintained by the Advisory Action is clearly flawed and the teachings of *Pepper* do not anticipate Claim 1. For these reasons, and the above-referenced reasons described in Applicants’ Response dated March 10, 2006, Applicants content that the rejection of Claim 1 is improper, as is the rejection of Claims 2-48 for the same or analogous reasons.

**CONCLUSION**

As the rejections of Claims 1-48 contain clear deficiencies, Applicants respectfully request a finding of allowance of Claims 1-48.

Applicants submit these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. The Commissioner is authorized to charge \$250.00 to cover the filing fee for the Notice of Appeal and \$510.00 for the extension fee to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this request that may be cleared up in a telephone conversation, please contact Applicants' attorney, Paula D. Heyman, at 512.322.2581.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorney for Applicants



Paula D. Heyman  
Reg. No. 48,363

Date: July 11, 2006

**SEND CORRESPONDENCE TO:**  
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